DOCKET NO: 241102US3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF	:	
TAKAYUKI YOSHIMI, ET AL.	:	EXAMINER: OJINI, EZIAMARA ANTHONY
SERIAL NO: 10/633,665	:	
FILED: AUGUST 5, 2003	:	GROUP ART UNIT: 3723
FOR: GRINDING METHOD AND GRINDING MACHINE	:	

RESPONSE TO RESTRICTION REQUIREMENT

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Restriction Requirement dated February 9, 2005, Applicants provisionally elect with traverse Group II, Claims 5-12, directed to a grinding machine. Applicants make this election based on the understanding that Applicants are not prejudiced against filing one or more divisional applications that cover the non-elected claims.

Applicants thank Examiner Ojini for the courtesy of the telephone call of January 31, 2005 to request an oral election. We appreciate the Examiner's efforts to efficiently prosecute the present application.

Applicants respectfully traverse the restriction requirement because of at least the following two reasons.

First, the stated basis for distinctness is improper. In this regard, page 2 of the requirement indicates that:

> ". . . the apparatus as claimed can be used to practice another and materially different process such a water jet."

However, the claimed apparatus is "a grinding machine" and the claimed method is "grinding method." Thus, if the apparatus could be used for "a water jet" as hypothesized in the outstanding Official Action, presumably so can the method be used for "water jetting," especially since the claimed method includes a recital of structural and functional limitations stated in the claimed apparatus. Accordingly, no undue burden is seen here since similar subject matter must be searched and considered relative to elected Claims 5-12. Thus, under MPEP § 803, "if the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions." Since the restricted claims would appear to be part of an overlapping search area, it is respectfully submitted that the burden on the Examiner would be minimal and the burden on Applicants would be significant if Applicants were required to file and prosecute a separate divisional application.

In any event, as noted in MPEP § 806.05(a) "the burden is on the examiner to provide reasonable examples that recite material differences." Since the "water jet" example offered is not reasonable in view of the common preambles and similar structural and functional recitations in the apparatus and method claims, it is respectfully submitted that the burden placed upon the Examiner has not been carried.

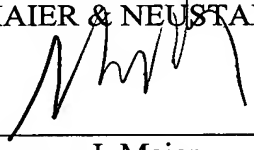
Applicants further traverse the outstanding Restriction Requirement as the outstanding Restriction Requirement has not established that an undue burden would be required if the Restriction Requirement was not issued and if all the claims were examined together. In the present application, based on the above-noted requirements of MPEP § 803, no undue burden has been established if each of the claims were examined together. Both groups of claims have been classified in Class 451. Although the outstanding Official Action identifies different subclass classifications, it is believed that the claims of the present application would have to be searched in a

handful of sub-classes. Furthermore, since electronic searching is commonly performed, a search may be made of a large number of, or theoretically all, subclasses without substantial additional effort. In contrast, the present restriction requirement subjects the Applicants to the added financial burden of prosecuting Claims 1-4 and Claims 5-12 in separate proceedings.

Accordingly, it is respectfully requested that the requirement to elect a single group be withdrawn, and that a full examination on the merits of Claims 1-12 be conducted.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



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